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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/380,781 09/09/99 YOSHINO

T 1165.759

EXAMINER

MMC2/0509

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SCHECHTER, A  
ART UNIT PAPER NUMBER

2871  
DATE MAILED:

05/09/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/380,781

Applicant(s)

YOSHINO ET AL.

Examiner

Andrew Schechter

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-17 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,10,11,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 2,5-9,12,13,18 and 19 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. Figures 5-10 and 19-24 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The phrase in claim 10, "wherein the light-cutting film and a plurality of transparent electrodes are formed by superposing them through the insulating film" is unclear to the Examiner. First, there is no "insulating film" mentioned elsewhere in the claim to which it could refer; second, "superposing them through the insulating film" does not give a clear description of how to make the invention.

The applicant should indicate what in the figures or specification is referred to by this phrase, and also provide an appropriate antecedent for "insulating film."

Claim 11 depends on claim 10.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5, 7, 12, and 6, 8, 9, 13, 18, 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 includes a limitation "on an area in which the light-cutting film is superposed with the sealing member and in the periphery of that area"; claim 7 includes a similar phrase in lines 4-7 on p. 35; claim 12 includes the phrase "at a portion in which the light-cutting film is superposed with the sealing member and the periphery thereof."

In each case, the meaning is unclear. In claim 5, for instance, the Examiner interprets the claim language to say that there is an area where the film superposes the sealing member and that the slits are in that area, and furthermore, in the periphery of that area. (Fig. 13 could be taken to show this.) However, the specification (1<sup>st</sup> paragraph, p. 28) might be read to imply rather that the slits are in the area, and the area is in the periphery of the device, which would give the claim a different scope. The difficulties with claims 7 and 12 are analogous. Applicant should clarify which of these meanings is intended in the claims.

Claims 6, 8, 9, 13, 18, and 19 depend on claims 5, 7, and 12.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 3, 4, and 20 are rejected under 35 U.S.C. 102(a) as being anticipated by *Sato et al.*, Japanese Patent No. 06-051332A.

Considering the limitations of claim 1, *Sato* discloses a liquid crystal apparatus comprising: first and second substrates [8 and 9], first and second electrodes [1 and 2], a sealing member [4] with conductive spacers [abstract], a non-pixel electrode and a dummy electrode [5 and 6, overlapping in the four corners of the device] wherein the dummy electrode is divided by a plurality of slits [Fig. 1]. Claim 1 is therefore anticipated by *Sato*.

The conductive spacers in *Sato* are inherently smaller than the width of the slits dividing the dummy electrode [else the device would not work], and the dummy electrode is parallel to and along the side of the sealing member. Claims 3 and 4 are therefore anticipated by *Sato*.

Considering claim 20, the device of *Sato* has a dummy electrode arranged opposite the drive electrode and has slits which prevent current flowing. Claim 20 is therefore anticipated by *Sato*.

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8. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by *Yanagisawa*, U.S. Patent No. 5,128,786.

*Yanagisawa* discloses a liquid crystal apparatus with a conductive light-cutting film [16] having a separation slit which prevents current and divides the film into a plurality of portions. Claim 21 is therefore anticipated by *Yanagisawa*.

### ***Allowable Subject Matter***

9. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 5, 7, and 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
11. Claims 6, 8-9, 13, and 18-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
12. Claims 14-17 are allowed.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,198,519 discloses a LCD with dummy electrodes having slits and an anisotropic conductive layer bonding the two sides. However, the slits are

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constructed to provide vernier patterns rather than being related to preventing currents, and the bonding is not explicitly disclosed as a liquid crystal seal.

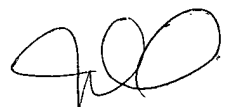
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Schechter whose telephone number is (703) 306-5801. The examiner can normally be reached on Monday - Friday, 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Sikes can be reached on (703) 308-4842. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Andrew Schechter  
May 4, 2001



**JAMES A. DUDEK**  
**PRIM**